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EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,330

Applicant(s)

YANG ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on October 27, 2005, wherein:

Claims 1-78 are currently pending;

Claims 1, 10, and 31 have been amended.

2. The Examiner also notes the applicant's disclosure of office actions filed on October 21, 2005, wherein the applicant encourages the Examiner to review the file history of the related application as some of the information contained therein may be material to the examination of the present application. The Examiner will review the related applications for double patenting issues. However, if there is prior art in related applications that the applicant finds relevant to this application, the applicant is requested to submit the prior art to the Examiner through an Information Disclosure Statement (IDS), wherein the Examiner will consider this prior art.

Claim Rejections - 35 USC § 101

3. The rejection under 35 U.S.C. 101 as to claims 1-39 has been ***withdrawn***.

Response to Arguments

4. Applicant's arguments filed October 27, 2005 have been fully considered but they are not persuasive.

5. Claim rejection – 35 USC Section 102:

Claims 1-27, 31-66 and 70-78 were rejected under 35 USC section 102(e) as being anticipated by Ginter (US 2004/0133793). The applicant states that Ginter was filed on June 25, 2003 and that the present application was filed on

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May 11, 2001. Thus, the applicant argues that because the present application has a filing date that is earlier than Ginter's filing date, Ginter cannot be used to reject Claims 1-27, 31-66, and 70-78 under 35 USC Section 102 (e).

MPEP Section 706 states:

If the publication or issue date of the reference is too recent for 35 U.S.C. 102(b) to apply, then the examiner should consider 35 U.S.C. 102(e). In order to apply a reference under 35 U.S.C. 102(e), the inventive entity of the application must be different than that of the reference. Note that, where there are joint inventors, only one inventor needs to be different for the inventive entities to be different and a rejection under 35 U.S.C. 102(e) is applicable even if there are some inventors in common between the application and the reference.

Revised 35 U.S.C. 102(e), as amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), and as further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), applies in the examination of all applications, whenever filed, and the reexamination of, or other proceedings to contest, all patents.

The filing date of the application being examined is no longer relevant in determining what version of 35 U.S.C. 102(e) to apply in determining the patentability of that application, or the patent resulting from that application. The revised statutory provisions supersede all previous versions of 35 U.S.C. 102(e) and 374, with only one exception, which is when all previous versions of 35 U.S.C. 102(e) and 374, with only one exception, which is when the potential reference is based on an international application filed prior to November 29, 2000. Furthermore, the provisions amending 35 U.S.C. 102(e) and 374 in Pub. L. 107-273 are completely retroactive to the effective date of the relevant provisions in the AIPA (November 29, 2000). See MPEP § 706.02(f)(1) for examination guidelines on the application of 35 U.S.C. 102(e).

706.02(f)(1) [R-3] Examination Guidelines for Applying References Under 35 U.S.C. 102(e)

I. DETERMINE THE APPROPRIATE 35 U.S.C. 102(e) DATE FOR EACH POTENTIAL REFERENCE BY FOLLOWING THE GUIDELINES, EXAMPLES, AND FLOW CHARTS SET FORTH BELOW:

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(A) The potential reference must be a U.S. patent, a U.S. application publication (35 U.S.C. 122(b)) or a WIPO publication of an international application under PCT Article 21(2) in order to apply the reference under 35 U.S.C. 102(e).

(B) Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (C) below. The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph. See MPEP § 2136.02.

In this application the potential reference is a US application publication that does not claim benefit of an international application. Thus, the proper filing date of this reference, taking into consideration the proper benefit claims to prior US applications under 35 USC 199(e) and 120 is 1995.

6. Claim rejections – 35 USC section 103:

Claims 28-30 and 67-69 were rejected under 35 USC section 103(a) as being unpatentable over Ginter.

The applicant argues that Ginter cannot be used to reject the claims of the present application under 35 USC Section 103 (a). The Examiner respectfully disagrees with this assertion and directs the applicant to MPEP Section 706.

MPEP Section 706 states:

Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment

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to the same person or organization at the time the claimed invention was made.

Thus, Ginter qualifies as prior art under 35 USC 103.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-27, 31-66, and 70-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al (US 2004/0133793) (hereinafter referred to as Ginter).

Referring to Claims 1 and 40:

Ginter discloses a computer implemented method and medium for managing multiple contracts ([0012] *under VDE, such an extended agreements may comprise an electronic contracts [0053]*), comprising:

receiving an inquiry (Figure 41a (1450);[0174] *support dynamic user selection (inquiry) of information subsets of a VDE; [0425] the "events" may include, for example, a **request to use content or generate a usage permission**; Figures 72A-72D; also see [0012], [0053], [0078-0081], [0093], [0161-0162] and [0137]*);

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accessing information comprising a set of one or more associated contract terms pertaining to the plurality of contracts (Figure 2A Rules and controls, Figures 5A and 5B **Permissions record** (808); [0053] *agreements include contracts; [0058], [0061- 0067] a rights application under VDE is made up of special purpose pieces, each of which can correspond to one or more basic electronic processes needed for a rights protection environment. These processes can be combined together like building blocks to create electronic agreements that protect these right [0078], VDE allows electronic arrangements to be created involving two or more parties, **these agreements can themselves comprise a collection of agreements** between participants in a commercial value chain and/or data security chain model for handling, auditing, reporting and payment [0093] electronic agreement between VDE participants that represent negotiation between, the control requirements of, two or more parties and **enacts terms and conditions of the resulting agreement**, [0107], VED permits multiple, separate electronic arrangements to be formed between subsets of parties; [0134] achieves the electronic contract/right protection environment)*

determining a plurality of contracts that are implicated by the inquiry ([0078], VDE allows electronic arrangements to be created involving two or more parties, **these agreements can comprise a collection of agreements** [0093] electronic agreement between VDE participants that represent negotiation between, the control requirements of, two or more parties and **enacts terms and conditions of the resulting agreement** [0166] VDE ensures that certain

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prerequisites necessary for a give transaction to occur are met [0107], [0161-0166])

processing the inquiry based upon one or more applicable contract terms ([0012] *these participants need the ability to embody their range of agreements and requirements, including use limitations, into and "extended" agreement, the extended agreement is represented by electronic content control information that can automatically enforce the agreed upon rights and obligations [0093] electronic agreement between VDE participants that represent negotiation between, the control requirements of, two or more parties and **enacts terms and conditions of the resulting agreement [0390]** rules and controls authorize use of the program, [0108] all requirements specified by this derived control information must be satisfied before VDE controlled content can be accessed or otherwise used[0161-0163], 0247)).*

Referring to Claims 10 and 49:

Ginter discloses a computer implemented method and medium for managing multiple contracts ([0012] *under VDE, such an extended agreements may comprise an electronic contracts [0053]), comprising:*

receiving a first inquiry regarding a first resource under a particular contract (Figure 41a (1450); [0174] *support dynamic user selection (inquiry) of information subsets of a VDE; [0425] the "events" may include, for example, a **request to use content or generate a usage permission [0012]** electronic contract, [0053], [0078-0081] electronic content, [0093], [0161-0162], Figures 72A-72D, [0137]);*

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accessing information pertaining to the contract, the information comprising quota parameter which specifies a quota of resources that can be consumed under the contract, and one or more contract terms associated with the contract ([0161-0162] [0166] **metering the number of copies, Figure 3 Usage report and Figure 4 Type of Usage, [0426-0433]**);

determining a first amount attributable to obtaining the first resource by applying one or more of the contract terms ([0012], [0405] *how much it costs to use the content, [0410-0411] specify how much it costs, [0426-0431]; Figure 26A (944) number of rights record; Figure 50d (1718)*);

updating the quota parameter based upon the first amount (*Figure 61 (2239) update Meter, [0393]*); and

allowing the first resource to be used under the contract ([0062] *Figure 3 (402) GO*).

Referring to Claims 31-33 and 70-72:

Ginter discloses a computer implemented method and medium for managing multiple contracts ([0012] *under VDE, such an extended agreements may comprise an electronic contracts [0053]*), comprising:

receiving a first inquiry regarding obtaining a first resource under a particular contract ([0174] *support dynamic user selection (inquiry) of information subsets of a VDE; [0425] the "events" may include, for example, a **request to use content or generate a usage permission** [0012] electronic contract, [0053], [0078-0081] electronic content, [0093],[0161-0162], Figures 72A-72D, [0137]*);

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accessing information pertaining to the contract [0061], the information comprising quota parameter which specifies a quota of resources that can be consumed under the contract, and one or more contract terms associated with the contract ([0161-0162] parameters, [0166] metering the number of copies, Figures 3 and 4, [0214], [0426-0433]);

accessing one or more other sets of information pertaining to one or more contract terms [0061] pertaining to one or more other contracts related to the contract (Figure 1A Permissioning Agent (200f), Figure 5A Permissions Record (808), Figure 5B (808); [0012] and [0161-0162] with capability parameter data to reflect elements of one or more express agreements [0163] terms and conditions are evaluated; Figures 3-4, [0061] [0077-0081]);

processing the information to derive one or more applicable contract terms that apply to the inquiry by reconciling the information to extract the applicable contract terms ([0061-0066] [0093] enacts terms and conditions of resulting agreement; [0163-0165] agreements result from an automated electronic process during which terms and conditions are evaluated; VDE installation may require that certain VDEF methods are employed, for example in a certain sequence, in order to be able to use all and/or certain classes, of electronic content and/or VDE applications);

determining a first amount attributable to obtaining the first resource by applying one or more of the contract terms ([0012], [0405] how much it costs to use the content, [0410-0411 specify how much it costs, [0426-0431]; Figure 26A (944) number of rights record; Figure 50d (1718);

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updating the quota parameter based upon the first amount (*Figure 61 (2239) update Meter, [0393]*); and

allowing the first set of software to be used under the contract ([0062] *Figure 3 (402) GO*).

Referring to Claims 2, 9, 41 and 48:

Ginter discloses wherein processing and reconciling comprises:

processing each of the plurality of contracts in a particular order ([0163-0165]) *certain VDEF methods are employed in a certain sequence*);

determining whether the contract has a contract term that applies to the inquiry ([0163-0165], [0166] *VDE ensures that certain prerequisites necessary for a given transaction to occur are met [0247]*);

upon finding a contract term, including the term as one of the one or more applicable contract terms ([0012] *participants need the ability to embody their range of agreements and requirements, including use limitations into an extended agreement [0061] a rights application under VDE is made up of special purpose pieces, each of which can correspond to one or more basic electronic processes needed for a rights protection environment [0161-0165]*).

Referring to Claims 3 and 42:

Ginter discloses determining which particular contract is being invoked by the inquiry and determining at least one other contract that is related to the particular contract ([0078] *these agreements can themselves comprise a collection of agreements [0163] junior party/senior party [0247] VDE electronic agreement can be composed, at least in part, of one or more subagreements,*

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these subagreements are comprised of one or more electronic contract compliance elements that ensure the protection of the rights of VDE participants [0248-0273]).

Referring to Claims 4 and 43:

Ginter discloses wherein the particular contract and the other contract are related to each other through a hierarchy ([0107] *subsets of parties [0061- 0067] a rights application under VDE is made up of special purpose pieces, each of which can correspond to one or more basic electronic processes needed for a rights protection environment. These **processes can be combined together like building blocks** to create electronic agreements that protect these rights, [0254] seniority of contributed control information [1209-1213] PERCs 808 are organized as a hierarchical structure, [0249-0255]).*

Referring to Claims 5 and 44:

Ginter discloses determining whether a set of contract terms associated with a particular contract comprises a contract term that applies to the inquiry ([0161-0163] *agreement may also result from an automated electronic process during which terms and conditions are “evaluated” by certain VDE participant control information that accesses whether certain other electronic terms and conditions attached to content and/or submitted by another party are acceptable; such an evaluation process may be quite simple, for example a comparison to ensure compatibility [0249] the control information can determine for example how and/or to whom electronic content can be provided); and*

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in response to the determination that terms do not apply, determining whether the terms of the other contract applies to the inquiry ([0161] VDEF capabilities “evolve” to reflect the requirements of one or more successive parties; [0163] VDE participants directly, through a user interface means, resolve “disagreements” between control information [0164] another party (other than the first applier of rules), perhaps through a negotiation process, accepts, and or adds to and/or modifies, “in place” content control information, a VDE agreement between two or more parties related to the use of such electronic content by be created; [0239], [1112]).

Referring to Claims 6 and 45:

Ginter discloses in response to a determination that the set of contract terms associated with the particular contract do apply, including the contract term as one of the one or more applicable contract terms ([0161] VDEF capabilities “evolve” to reflect the requirements of one or more successive parties; [0163] VDE participants directly, through a user interface means, resolve “disagreements” between control information [0164] another party (other than the first applier of rules), perhaps through a negotiation process, accepts, and or adds to and/or modifies, “in place” content control information, a VDE agreement between two or more parties related to the use of such electronic content by be created (so long as any modifications are consistent with senior control information; [0239], [1112]).

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Referring to Claims 7 and 46:

Ginter discloses in response to a determination that the set of contract terms associated with the other contract does apply, including the term in the one or more applicable contract terms (*([0161] VDEF capabilities “evolve” to reflect the requirements of one or more successive parties; [0163] VDE participants directly, through a user interface means, resolve “disagreements” between control information [0164] another party (other than the first applier of rules), perhaps through a negotiation process, accepts, and or adds to and/or modifies, “in place” content control information, a VDE agreement between two or more parties related to the use of such electronic content by be created (so long as any modifications are consistent with senior control information [0239], [1112]).*

Referring to Claims 8 and 47:

Ginter discloses wherein the contract terms associated with a particular one of the plurality of contracts may differ from the contract terms associated with another of the plurality of contracts, and wherein processing the information comprises reconciling the terms to derive one or more applicable contract terms (*[0161-0163] agreement may also result from an automated electronic process during which terms and conditions are “evaluated” by certain VDE participant control information that accesses whether certain other electronic terms and conditions attached to content and/or submitted by another party are acceptable; such an evaluation process may be quite simple, for example a comparison to ensure compatibility between a portion of, or all senior terms and conditions in a table of terms and conditions; VDE participants directly, through a user interface*

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means, resolve "disagreements" between control information [0164] another party (other than the first applier of rules), perhaps through a negotiation process, accepts, and or adds to and/or modifies, "in place" content control information, a VDE agreement between two or more parties related to the use of such electronic content by be created (so long as any modifications are consistent with senior control information).

Referring to Claims 11-15 and 50-54:

Ginter discloses wherein the first resource comprises a product, a service, a license to a set of property, wherein the property comprises intellectual property or proprietary information ([0017] *electronic information products* [0025 *electronic products*], [0046-0053], [0071]).

Referring to Claims 16-19 and 55-58:

Ginter discloses wherein the one or more contract terms comprises an uplift, a discount, a multiplier or an additional resource to be included with the first resource ([0174 *a certain quantity of certain text could mean associated images might be discounted by 15%* [0186-0190] *upgrade pricing, pricing discounts*).

Referring to Claims 20 and 59:

Ginter discloses receiving a second inquiry regarding obtaining a second resource under the particular contract ([0025], [0046-0052], [0071], [0093], [0161-0162], [0174]);

accessing the information pertaining to the particular contract ([0161-0163] *Figure 2A Rules and controls, Figures 5A and 5B Permissions record* (808);

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*[0053] agreements include contracts; [0058], [0061- 0067] a rights application under VDE is made up of special purpose pieces, each of which can correspond to one or more basic electronic processes needed for a rights protection environment. These processes can be combined together like building blocks to create electronic agreements that protect these rights, [0078], VDE allows electronic arrangements to be created involving two or more parties, **these agreements can themselves comprise a collection of agreements** between participants in a commercial value chain and/or data security chain model for handling, auditing, reporting and payment [0093] electronic agreement between VDE participants that represent negotiation between, the control requirements of, two or more parties and **enacts terms and conditions of the resulting agreement**, [0107], VED permits multiple, separate electronic arrangements to be formed between subsets of parties; [0134] achieves the electronic contract/right protection environment) , Figures 3 and 4 [0214], [0426-0433]);*

determining a second amount attributable to obtaining the second resource by applying one or more contract terms ([0112] VDE can employ secure metering, Figures 2 and 4 [0249-250] [0405] the usage related "rules and controls" may specify what a user can and can't do with the content and how much it costs to use the content [0410-0411], [0426-0431] meter process, Figure 26A (944), Figure 50d(1718);

updating the quota parameter based on the second amount (Figure 61 (2239) update METER [0393] VDE will "meter" each time a consumer watches the video); and

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allowing the second resource to be obtained under the contract ([0062] Figure 3 (404) GO).

Referring to Claims 21 and 60:

Ginter discloses wherein the second resource is of a different type than the first resource ([0012], [0061], [0107], [0161] [0165-0166] *this same provider might also charge fees based on the total number of different properties licensed from them by the user [1126] the "content" may be any sort of electronic information, also see [2320]*)

Referring to Claims 22 and 61:

Ginter discloses herein the one or more contract terms applied to determine the first amount are different from the one or more contract terms applied to determine the second amount ([0161-0166] *this would require the execution of a metering method for copying of the property each time a copy was made for another employee. The same provider may also charge fees based on the total number of different properties licensed from them by the user and a metering history of their license [0202] an individual, and/or a class or other grouping of end users, may have different costs [0273] VDE agreements support evolving (living) electronic agreements*).

Referring to Claims 23 and 62:

Ginter discloses wherein the one or more contract terms applied to determine the first amount are the same as the one or more contract terms applied to determine the second amount ([0161-0165] [0273] *content control information for a given piece of content may be stipulated as senior information*

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and therefore, not changeable, might be put in place by a content creator and might stipulate that national distributors given piece of their content may be permitted to make 100/00 copies per calendar quarter, so long as such copies are provided to bona fide end-users, but may not pass only a single copy of such content to a local retailer and the control information limits the such a retailer to making no more than 1,000 copies per month for retail sales to end-users).

Referring to Claims 24 and 63:

Ginter discloses reducing the quota parameter by the first amount (*Figure 61 (2239) update meter, [0393] VDE will meter each time a consumer watches the video [0161]*).

Referring to Claims 25 and 64:

Ginter discloses wherein the first inquiry specifies one or more additional inquiry parameters and wherein the first amount is determined based upon at least one or more additional inquiry parameters (*Figure 72A-72D, [0214] flexible metering, enables such flexibility of metering control mechanisms to accommodate different parameters, [0055] [0108] allows electronic commerce participants to freely stipulate their business requirements and trade-offs*).

Referring to Claims 26 and 65:

Ginter discloses wherein at least one or the one or more additional inquiry parameters is specifiable by a sender of the inquiry (*Figure 72A-72D [0111] VDE can further be used to enable commercially provided electronic content to be made available to users in user defined portions*).

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Referring to Claims 27 and 66:

Ginter discloses determining, using additional inquiry parameters, which of the one or more contract terms apply to the first inquiry ([0061- 0067] *a rights application under VDE is made up of special purpose pieces, each of which can correspond to one or more basic electronic processes needed for a rights protection environment. These processes can be combined together like building blocks to create electronic agreements that protect these rights, [0078], VDE allows electronic arrangements to be created involving two or more parties, **these agreements can themselves comprise a collection of agreements between participants in a commercial value chain and/or data security chain model for handling, auditing, reporting and payment [0093] electronic agreement between VDE participants that represent negotiation between, the control requirements of, two or more parties and **enacts terms and conditions of the resulting agreement, [0107], VED permits multiple, separate electronic arrangements to be formed between subsets of parties; [0134] achieves the electronic contract/right protection environment***** [0161-0165]).

Referring to Claims 34-35, 37-39, 73-74, and 76-78:

Ginter discloses processing the set of information in a particular order, searching as each set is processed for contract terms that apply and finding a contract term that applies [0061- 0067] *a rights application under VDE is made up of special purpose pieces, each of which can correspond to one or more basic electronic processes needed for a rights protection environment. These*

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processes can be combined together like building blocks to create electronic agreements that protect these rights, [0161-0165].

Referring to Claims 36 and 75:

Ginter discloses, in response to a determination that the information does not comprise a contract term that applies, deriving the one or more applicable contract terms from other sets ([0161-0164] ([0161-0163] agreement may also result from an automated electronic process during which terms and conditions are "evaluated" by certain VDE participant control information that accesses whether certain other electronic terms and conditions attached to content and/or submitted by another party are acceptable; such an evaluation process may be quite simple, for example a comparison to ensure compatibility between a portion of, or all senior terms and conditions in a table of terms and conditions; VDE participants directly, through a user interface means, resolve "disagreements" between control information [0164] another party (other than the first applier of rules), perhaps through a negotiation process, accepts, and or adds to and/or modifies, "in place" content control information, a VDE agreement between two or more parties related to the use of such electronic content by be created (so long as any modifications are consistent with senior control information))

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28-30 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter.

Referring to Claims 28-30 and 67-69:

Ginter discloses a computer-implemented method for managing multiple contract ([0012] electronic contracts). Ginter discloses usage auditing, reporting, and payment [0078]. Ginter does not disclose determining a refund amount and updating the quota parameter based upon the refund.

However, customer service is a key factor in the success of any business. One way to keep customers satisfied to provide refunds for unused portions or providing credits for the unused portion. This practice of giving a customer a refund for unused portions is an old and well established business practice, for example, when a customer is dissatisfied with the product and wants to return the product. The practice is designed to keep customers returning for services.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate into the contract management method and medium disclosed in Ginter a refund mechanism since it makes good business sense to provide a credit for unused portions so as to maintain customer satisfaction and loyalty, thus generating return business.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

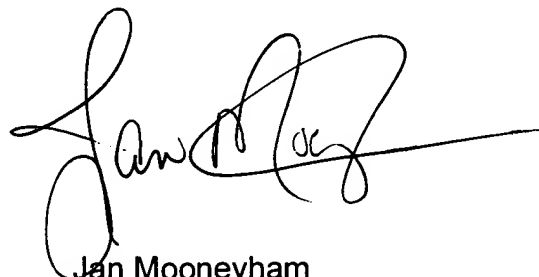
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
Art Unit 3629